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In re Application of: :
Konradi et al. :
Serial No.: 10/804,950 : PETITION DECISION
Filed: March 19, 2004 :
Attorney Docket No.: 04843/120003 :

This is in response to the petition under 37 CFR § 1.181, filed July 31, 2009, requesting that the finality of the Office action of July 9, 2009 be withdrawn.

BACKGROUND

The examiner mailed a non-final Office action on January 8, 2009 setting a three month statutory limit for reply. At the time of this non-final Office action, claims 1, 2 and 39-41 were pending. The examiner rejected claims 1-2 and 39-41 under 35 USC 102 (e) as being anticipated by Wallace et al. Claims 1 and 39-41 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Wallace et al. in view of Lockhart et al. Claims 1 and 39-41 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Seitink et al. in view of Lockhart et al. Claim 2 was also objected to for reciting nonelected subject matter.

In reply to the non-final Office action of January 8, 2009, applicants filed a response on April 7, 2009. The response submitted by applicants included remarks, arguments traversing the rejections made in the non-final Office action, and amendments to the claims.

On July 9, 2009, the examiner mailed a final Office action setting a three month statutory limit for reply. At the time of this final Office action, claims 1, 2 and 39-41 were pending. Claims 1 and 39-41 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Van den Heuvel et al. in view of Lockhart et al. Claims 1-2 and 39-41 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Wallace et al. in view of Van den Heuvel et al. and Papaconstantinou et al. Claim 2 was again objected to for reciting nonelected subject matter. The examiner made the action Final and stated that Applicants' amendment necessitated the new ground(s) of rejection citing MPEP § 706.07(a).

In response thereto, applicants filed this petition on July 31, 2009, requesting that the finality of the Office action of July 9, 2009 be withdrawn.

DISCUSSION

The petition and the file history have been carefully considered.

In the petition filed by applicants on July 31, 2009, applicants request reconsideration of the final Office action mailed by the examiner on July 9, 2009 asserting that the final rejection was premature and improper. Specifically, applicants argue "the critical issue in determining if a claim amendment "necessitates a new ground of rejection" is whether the rejection could have been made prior to that amendment being entered. Because the rejections set forth in the July 9, 2009 Office action can be applied to claim 1 prior to the April 7, 2009 amendment, this amendment did not necessitate the new grounds for rejection in the final action. Accordingly, it is improper to make this action final." Applicants further point out that "claim 1 was amended on April 7, 2009 to remove language directed to a "solid support." The term "microarray," as recited in claim 1, is defined by the specification as including a solid support. As set forth below, none of the rejections in the final action hinges on the explicit recitation of the term "solid support." Accordingly, each of these rejections could have been presented before the April 7, 2009 claim amendment."

The following excerpt from the MPEP § 706.07 was also cited in support of applicants' assertions:

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).

The examiner's rejections of the claims under 35 U.S.C. § 103 (a) in the final Office action were new rejections considering that the examiner did not originally institute said rejection(s) in the non-final Office action. While new rejections are permitted in final Office actions, such new rejections are only proper under certain circumstances according to the provisions set forth in the MPEP; those provisions being, either when applicants' amendment to the claims necessitates such a rejection or when an IDS submitted by applicants necessitates such a rejection, see MPEP citation (*Id.*) Since no IDS was submitted by applicants in the interim between the mailing of the non-final Office action and the final Office action and the claim amendments of April 7, 2009 did not alter the scope of the claims, applicants' arguments are well-taken and found persuasive. In view of the evidence, the final Office action issued July 9, 2009 is found premature and thus in error. Consequently, the finality of the Office action will be withdrawn in favor of applicants.

DECISION

The petition is **GRANTED.**

This application will be forwarded to the examiner for an action not inconsistent with this decision.

Should there be any questions about this decision please contact Marianne C. Seidel, by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0584 or by facsimile sent to the general Office facsimile number, 703-872-9306.

A handwritten signature in black ink, appearing to read "Michael D. Wityshyn", with a stylized flourish at the end.

Mike Wityshyn
Acting Director, Technology Center 1600